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SEP 1 3 1949

No. 231

Supreme Court of the United States.

OCTOBER TERM, 1949.

STANDARD DUPLICATING MACHINES COMPANY, INC.,
Petitioner,

v.

AMERICAN BUSINESS MACHINES CORPORATION,
Respondent.

REPLY BRIEF FOR PETITIONER.

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1. Respondent argues that public policy requires that doubts as to the necessity of a disclaimer "should be resolved in favor of the public," i.e., against the patentee.

This argument has no bearing on whether certiorari should be granted. We submit that the writ should be granted because the case raises an important question of Federal law which has not been settled by this Court, viz.: Are claims which differ from each other in the breadth of the monopoly claimed definitely distinguishable from each other? Also, the writ should be granted because the Court of Appeals for the First Circuit has decided an important question of Federal law in a way in conflict with the decision of this Court in *Maytag Co.* v. *Hurley Machine Co.*, 307 U.S. 243.

The patentee in the case at bar may or may not be guilty of asserting an illegal monopoly, depending on how the fundamental question stated above is answered. The question should be answered once for all, so that patentees will not be tempted to assert too extensive monopolies on

the excuse of differing facts, and the public can tell as a matter of law whether or not the legal monopoly is being exceeded.

Public interest requires a clear, definite rule as to the necessity for a disclaimer.

Until this Court squarely decides whether or not a difference in scope renders claims definitely distinguishable, the public and the patentee will be left in a state of uncertainty and the courts will be burdened with unnecessary litigation over questions of fact.

2. Respondent argues that the six cases involving interpretation of the phrase "definitely distinguishable" show that a difference in scope is not enough to differentiate claims.

In none of the cases in question except the *Bruce* case [1] did the difference in wording of the claims affect the breadth of the monopoly granted.

Respondent discusses the facts of the *Maytag* case, *supra,* but the discussion is beside the point because the Court found expressly that the claims (38 and 39) "described but a single method" and were "the same except in verbiage." Therefore, the case raised no question as to the necessity of a disclaimer where a difference in scope existed.

As to the Bulldog case,[2] respondent again discusses the facts but overlooks the statement by the court that the claims cover the same construction and, therefore, were not definitely distinguishable. The court said:

> "Despite the difference in language, *what each of the claims covers* when read in the light of the specifi-

[1] *E. L. Bruce Co.* v. *Bradley Lumber Co.*, 79 F. Supp. 176.

[2] *Bulldog Electric Products* v. *Cole Electric Products Co.*, 148 F. (2d) 792, 794.

> cation in the patent is not definitely distinguishable *from the coverage of the other.*"

The case, therefore, is the same as the *Maytag* case in this respect and did not hold that a difference in scope does not render claims definitely distinguishable. In addition, it is to be noted that the differences between the two claims related to minor details of construction which had nothing to do with the essence of the invention.

In the Apex case[3] the gist of the invention was apparently the "means cooperating with said retaining device and acting to prevent its disengagement." As far as the invention is concerned, the particular form which the retaining device took—whether it was a pin or something else—was of no consequence. Each claim asserted the same monopoly against the public.

In the Duraloy case[4] the statement of facts is too meager to permit an analysis of the claims, but the court seems to have believed that the feature of adjustability, which was the only distinction between the claims, had nothing to do with the alleged invention.

In the Wiegand case[5] three patents were held invalid for failure to disclaim. The grounds appear best from the decision of the District Judge.[6]

As to the first of these patents, the court said:

> "The real point is that whatever distinction may exist between the two claims is upon a point which has not the slightest real bearing upon the essence of the real invention."

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[3] *Apex Electrical Co. v. Maytag Co.*, 122 F. (2d) 182.
[4] *Duraloy Co.* v. *Carnegie Illinois Steel Corp.*, 43 F. Supp. 291.
[5] *Wiegand* v. *H. E. Trent Co.*, 122 F. (2d) 923.
[6] *Wiegand* v. *H. E. Trent Co.*, 43 U.S. P.Q. 149.

As to the second patent the court said:

> "It seems plain that this is a trivial detail of construction, having little, if anything, to do with the object of the patent."

And as to the third patent, the court said:

> "No one contends that the form—strip, disk, or ring —has anything to do with the invention claimed."

It is clear that in each case the monopoly asserted by the two claims did not differ in scope or extent.

In the *Bruce* case[7] the invalid claim called for "heat which penetrates," whereas the narrow claim specified "radiation, predominantly infra red in wave length." Heat applied externally, although it penetrates, did not produce the effect produced internally by infra-red rays. One claim was broad enough to cover many methods of heating; the other covered only one and there was, therefore, a clear difference in scope at the exact point of novelty, and this difference produced a difference both in "operation and result" as required by the *Maytag* case. We submit that the *Bruce* case squarely decided that two claims which were different in scope were "definitely distinguishable" within the meaning of the disclaimer statute.

Respondent, in its paragraph on page 5 headed "Argument," says: "The present case does not present any conflict whatsoever with previously cited cases."

This is clearly incorrect since the Court of Appeals in the case at bar held that two claims which were admittedly different in scope were not on that account definitely distinguishable, while in the *Bruce* case the court reached the contrary conclusion. The case at bar does not present any conflict of decision between Circuit Courts of Appeals

[7] *E. L. Bruce Co.* v. *Bradley Lumber Co.*, 79 F. Supp. 176.

but the reasoning of the Court of Appeals for the First Circuit in the case at bar is squarely in conflict with that of the District Judge in the *Bruce* case.

3. Respondent argues, pages 11 to 14 of its Brief, that a difference in concept is required to render two claims "definitely distinguishable."

The function of the claims of a patent is to state the "metes and bounds" of the monopoly granted by the patent. Like the boundaries described in real-estate deeds, they define the territory which is the sole property of the patentee. The phrase "definitely distinguishable" in the disclaimer statute refers to the metes and bounds of the monopoly. To be definitely distinguishable, the territories covered by the claims must not be coextensive, since, if they were, there would be no difference in "operation or result" as required by the *Maytag* case. Respondent's "concept" theory, therefore, goes far beyond the rule of the *Maytag* case. Although it did not adopt respondent's concept theory explicitly, the Court of Appeals went contrary to the decision of this Court in the *Maytag* case in holding that the claims were not definitely distinguishable notwithstanding differences in "operation and result" which went to the very essence of the invention.

In conclusion, we submit that the writ of certiorari should be granted, *first*, because a question of the interpretation of a Federal statute is raised and, *second*, because the Court of Appeals for the First Circuit has decided the case contrary to the decision of this Court in the *Maytag* case.

Respectfully submitted,

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